With the Notice of Appeal, Applicant presents the following remarks.

REMARKS

There are three independent method claims, 126, 128, and 129, and three corresponding independent system claims, 138, 142, and 145.

Claims 129 and 145

Applicant addresses first claim 129 and its corresponding system form claim, 145. By the various exchanges, the issue for these claims has become focused on whether a method or system with the last element is obvious. The last element is:

> "making the record available for look-up by anyone from any computer on the publicly accessible network."

In the final office action, the Examiner asserts that this element is obvious because "Johnson et al discloses a publicly accessible network and storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network". It is true that Johnson teaches making the record available for look up by persons with certain management authorization, but Johnson does not teach making it accessible "by anyone". Johnson explicitly teaches away from making it accessible by anyone.

The Examiner maintains that, because Johnson teaches "that potential licensees are allowed access to the system," it is therefore obvious that anyone might be allowed access to all the records of what licenses have been granted and to whom. This does not follow. Just because all people are allowed access to some parts of the system and only administrators are allowed access to the records of what licenses were granted and to whom, it is not obvious that ALL people should be allowed access to the records of WHAT LICENSES WERE GRANTED AND TO WHOM. Johnson teaches that only administrators should have access to these records.

All web sites that are accessible on a network have some components that are accessible to more people and some components that are accessible to fewer people. There is no web site where all components have the same degree of availability to all.

These differences are generally established by adjusting "security settings." For example, for most web sites, only the site administrator or the host operator can delete files, and there are typically some files for the web site that even the site administrator can not delete and can not fully erase by writing over each spot on the hard disk where the data was stored, this function being limited to the host operator. As a more relevant example for the present issue, the site administrator usually has the power to revise any data that is presented on the site and others usually have very limited power or no power to revise data that is presented on the site. It is also common that a site will allow the world to view certain data collected at the site and allow only the site administrator to view other data collected at the site, such as number of site visits or IP addresses of visitors.

In the relevant prior art for claim 129, Johnson, only the site administrator is allowed to view certain data, that is, records of who had obtained a license to use a work of authorship. This information is not made available to the general public. The question that the applicant and the Examiner are grappling with is whether making this information available to the general public is obvious. Although this change from the prior art can easily be made by a programmer, this does not answer the question of whether it was obvious to do so.

The body of the application articulates extensively that making this information available to the general public is non-obvious and is an important invention. I quote from the application with underlining added for emphasis:

BACKGROUND OF THE INVENTION

This invention addresses the problem of how to obtain licensing permission to use material created by another and how to present assurances that permission was obtained for the use.

The Internet has presented serious challenges to the established copyright clearance systems. Many forms of works of authorship are now published digitally on the Internet, including text, audiowave recordings, digital music specifications, still images, and videos. When these works of authorship are received by a client computer on the Internet, a copy can very easily be made on the client computer. The copy can then be

reproduced, distributed, performed, displayed, or used to prepare a derivative work. Although it is very easy to make such uses of source works of authorship, it is very difficult to find the owners of copyrights in these works or their agents and obtain licenses. Furthermore, even if the source work of authorship is used with permission, it is difficult for a person viewing the reproduced work, including the owner of copyrights in the source, to verify that the source was, in fact, used with permission without exceeding the scope of the license.

Inventors have attempted to solve this problem by presenting technical means to prevent or discourage unauthorized use of works of authorship. These methods include using public key encryption to verify certificates of authority which are attached to works of authorship to prove that licenses have been obtained. They also include various methods of applying watermarks to a digital work of authorship to trace the reuse of a work.

"SUMMARY OF THE INVENTION

"Rather than presenting technical barriers to unauthorized use or providing means to discover or prove unauthorized use, this invention makes it much easier to obtain licenses (or "clearances") to use source material and to verify that the material has been used within the scope of the license. While some users will pirate materials given the opportunity, the vast majority will obtain a proper license if it can be done quickly and easily and they can easily prove to others that they obtained the proper license.

"In another aspect, the invention is a method for granting licenses to use a work of authorship and publishing records of licenses granted. The server of the licensing web page then automatically creates a license record associated with the license that has been granted. The license record is given a unique license identifier which can be used to find the license record on the network. The unique license identifier is then transmitted to the licensee for presentation with each licensed use of the source work of authorship. When the licensee publishes or otherwise uses the source material, the licensee presents the unique license identifier so that each recipient of the material can use the unique license identifier to access on the network the license record and determine the scope of the license that was granted.

"When the licensee publishes or otherwise uses the source content, the licensee places an ICL tag on the licensee's material. Like the PRC tag, the ICL tag is embedded in both machine readable form and human readable form. Selecting a hotspot associated with the machine readable tag will direct a user's web browser to the license data record where the license information can be verified. The human readable ICL tag can be used to manually find the license data record by typing it into a browser."

As described in the application above, the invented method is a solution to the problem of easy unauthorized copying of works of authorship that is completely different from the prior art solutions to this problem. Johnson does not even attempt to address this problem. There is nothing in the prior art, especially not in Johnson, which suggests this solution to the problem or motivates this solution to the problem. The prior art solutions of technical copy restriction and watermarking and the like all teach away from this solution. In contrast to the prior art technical solutions, the invention exploits the fact that humans are social animals and care what other people think of them when their actions are published for anyone to check on.

There is no teaching in Johnson that provides a suggestion or motivation to make the change to the Johnson system suggested by the Examiner. The examiner points out that "potential licensees" are allowed to access certain data in the system. However, they are not allowed to access "a record of the accepted license" as specified by element (f) of claim 129. The fact that they are members of the general public and are allowed access to some data does not make it obvious that they should be allowed access to other data to which only administrators are allowed access as taught by Johnson.

Thus, the examiner has not made a prima facie case of obviousness. Independent method claim 129 and the corresponding system claim 145 should be allowed at this time, along with the claims that depend from them.

Proposed resolution prior to briefing on appeal

As a possible resolution to the issues of this case, Applicant proposes that, if the two independent claims discussed above are allowed, Applicant will agree to a cancellation of the remaining independent claims and the claims that depend from them.

Respectfully submitted,
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